

U.S. Patent Appl. No. 10/804,120  
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### **III. REMARKS**

#### **Preliminary Remarks**

Reconsideration and allowance of the present application based on the following remarks are respectfully requested. Claims 16-36 are currently pending and remain at issue. This response to the official communication is timely filed.

On page 2 of the official action, the examiner objected to the specification for allegedly lacking proper sequence identifiers. Specifically, the examiner alleged that various nucleic acid sequences disclosed in the application were not accompanied by the proper SEQ ID NO. The applicants have amended the specification at pages 15-17, and 26 to properly identify the sequences associated with the sequence identification number. In view of the foregoing amendment, the applicants respectfully submit that the objection of the specification has been overcome and should be withdrawn.

On page 4 of the official action, the examiner objected to claims 29-36 as being dependent upon a rejected base claim. The examiner asserted that these claims would be allowable if rewritten in independent form. The applicants have amended claims 16, 19, 23, and 26 have been rewritten in independent form and would not be subject to a double patenting rejection under 35 U.S.C. §101. Process claims 29-36 that ultimately depend from independent claims 16, 19, 23, and 26 would not be subject to the double patent rejection as well. In view of the foregoing amendment and remarks, the applicants respectfully request that the objection of claims 29-36 as being dependent upon a rejected claim has been overcome and should be withdrawn. The applicants do not intend by these or any amendments to abandon subject matter of the claims as originally filed or later presented, and reserve the right to pursue such subject matter in continuing applications.

#### **Patentability Remarks**

##### ***Rejection Pursuant to 35 U.S.C. §101***

On page 2 of the official action, the examiner rejected claims 15 and 22 under 35 U.S.C. §101 as allegedly claiming the same invention as that of claims 3 and 4 in U.S. Patent No. 6,861,246. Solely to expedite prosecution and without prejudice to the applicants' right

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to seek broader claims in a continuing application, claims 15 and 22 have been canceled thereby rendering the rejection moot. Amended claim 16 is directed to a vector comprising a nucleotide sequence as set forth in SEQ ID NO: 5. Amended claim 19 is directed to a vector comprising a nucleotide sequence as set forth in SEQ ID NO: 5 that is operatively linked to a *Corynebacterium dapA* gene. Amended claim 23 is directed to a vector comprising a nucleotide sequence as set forth in SEQ ID NO: 6. Amended claim 26 is directed to a vector comprising a nucleotide sequence as set forth in SEQ ID NO: 6 that is operatively linked to a *Corynebacterium dapA* gene. Amended claims 16, 19, 23 and 26 have been re-written in independent form and comprise either the promoter nucleotide sequences as set forth in SEQ ID NOS: 5 or 6. The vector, host cell, and process claims of this application do not claim the same invention as U.S. Patent No. 6,861,246. In view of the foregoing amendment and remarks, the applicants respectfully submit that the rejection of claims 15 and 22 under 35 U.S.C. §101 is now moot and should be withdrawn.

***Rejection Pursuant to the Judicially Created Doctrine of Obviousness-Type Double Patenting***

On page 3 of the official action, the examiner rejected claims 16-21 and 23-28 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1 and 5 of U.S. Patent No. 6,861,246 (hereafter the '246 patent). Specifically, the examiner alleged that the specification of the '246 patent discloses both wild and two mutant type promoters for use in the disclosed strains and methods. The examiner asserted that the vector and host cells of the instant claims are not patentably distinct from those patent claims 1 and 5.

According to 37 C.F.R. §1.130(b), a rejection based upon double-patenting may be overcome in a common ownership situation by filing a terminal disclaimer in compliance with 37 C.F.R. §1.321(c). The applicants assigned their inventorship rights to Degussa AG. The assignee has a common ownership between this application and the conflicting '246 patent. Therefore, enclosed is a terminal disclaimer signed by the attorney of record. In view of the foregoing submission, the applicants respectfully request that the rejection of claims 16-21 and 23-28 under the judicially created doctrine of obviousness-type double patenting has been overcome and should be withdrawn.

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#### IV. CONCLUSION

In view of the foregoing, the claims are now believed to be in form of allowance, and such action is hereby solicited. If any point remains which the examiner feels may be best resolved through a personal or telephone interview, please contact the undersigned at the telephone number below.

Respectfully submitted,

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